

Atty. Docket No. 439241

REMARKS/ARGUMENTS

The amendments and remarks hereto attend to all outstanding issues in the pending office action of 30 November 2005. Claims 1-20 are pending in this application; claims 1-20 stand rejected. Claims 5-10 and 15-18 are amended. Claim 19 has been rewritten in independent form.

In the Claims

35 U.S.C. § 112, ¶2 Rejections

Claims 5-10 are rejected under 35 U.S.C. § 112, ¶2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. In particular, the language "one or more" has been rejected as unclear. The claims have been appropriately amended to instead state "at least one", in accordance with the examiner's suggestions. As such, Applicant respectfully requests the withdrawal of the current 35 U.S.C. § 112, ¶2 rejections.

35 U.S.C. § 102 Rejections

Claims 1-4 and 6 are rejected under 35 U.S.C. § 102(b) as being anticipated by Bjork (U.S. 2,225,293), and claims 7, 8, 10, and 13-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hess (U.S. 6,062,585).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaul Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

Claim 1

Applicant respectfully contends that the examiner is mistaken in continuing to equate "being removable from and replaceable to" with "interchangeable", and Applicant notes that the limitation "being removable from and replaceable to" is purposefully used in Applicant's claim 1. "Interchangeable" is used in Bjork ('239) to mean that sections are "exact replicas" of other sections. Bjork, page 1, col. 2, lines 9-10. This is done so

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that "it is possible to produce a number of sections at a time, using the same tools, and great accuracy in the alinement of succeeding sections in making up a runner is secured". Bjork, page 1, col. 2, lines 13-17. In other words, one runner section is as appropriate to use as another runner section when the runner sections are being attached to the ski. This definition is in agreement with both the use of "interchangeable" in Bjork ('293) and the dictionary definition cited by the examiner; one runner section may be substituted for another runner section before being attached to the ski. However, nothing in Bjork ('293) or the dictionary definition cited by the examiner suggests that the Bjork ('293) runner sections are "removable from and replaceable to" a ski (or in other words, "interchangeable after being attached to a ski").

As Applicant noted in his response filed 7 September 2005, the Bjork "metal runners", while interchangeable, are not taught as being removable from and replaceable to a board body. Bjork does not mention removing or replacing the "metal runners" and, in fact, advocates features of these "runners" that could make their removal and/or replacement difficult or impossible. For example: "I have found it to be necessary to make the runners in sections, each section being secured to the ski entirely independently of the other sections, and the ends of adjacent sections being so formed and so joined as to not only prevent the movement of the end of any section laterally of the ski, but also vertically thereof..." Bjork, page 2, col. 1, lines 55-61, emphasis added. "This interlocking of the ends of adjacent sections relieves the means used in securing each section to the ski..." Bjork, page 2, col. 2, lines 2-4, emphasis added. "The rearward section 17 is provided with a central and forwardly projecting tongue 24 adapted to enter and have a close sliding fit with the channel 18, the end of this tongue being inwardly and forwardly beveled at 25 so as to pass below and interlock with the bevel 21." Bjork, page 2, col. 2, lines 30-35. Bjork, therefore, anticipates that the "metal runners" of his ski will "join" and "interlock", features that are not conducive to removal and replacement.

The examiner's statement on page 6 of the 30 November 2005 Office Action that it "would have been counterintuitive to form interchangeable edge sections for a board if the sections are 'difficult or impossible' to remove, as suggested by applicant" illustrates

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that the examiner did not fully appreciate Bjork ('293) or the difference between "interchangeable" and "removable from and replaceable to". Applicant has explained herein, simply by citing Bjork ('293), why the Bjork runner sections are interchangeable and the difference between "removable from and replaceable to" and "interchangeable". Because Bjork ('293) does not set forth every element in claim 1 (i.e., "each of the edge sections being removable from and replaceable to, the board body"), as required to sustain an anticipation rejection under *Verdegaal*, Applicant respectfully requests reconsideration and allowance of claim 1 and claims 2-6, 11, and 12 that depend therefrom.

Claim 3

Applicant notes that the limitation "inter-matched" in claim 3 is similar to the limitation "interchangeable" addressed above in the discussion of claim 1. Therefore, the gliding board of Applicant's claim 3 has a plurality of edge sections that may be interchanged ("inter-matched") and removed from and replaced to a board body. As discussed above, the Bjork ('293) edge sections are only interchangeable (i.e., capable of being inter-matched). Since Bjork ('293) does not set forth every element in claim 3 (i.e., "each of the edge sections being removable from and replaceable to, the board body"), as required to sustain an anticipation rejection under *Verdegaal*, Applicant respectfully requests reconsideration and allowance of claim 3 and claim 4 which depends therefrom.

Claim 4

Applicant respectfully points the examiner to MPEP § 706.07, where it is clearly stated that, "The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." Applicant respectfully contends that by not addressing Applicant's arguments with respect to claim 4 made in the response dated 7 September 2005, and instead reprinting the examiner's previous position verbatim, the examiner has not aided in developing clear issues between Applicant's position and the examiner's position or in providing Applicant a full and fair

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hearing. Applicant is at a loss as to how his earlier arguments (presented substantively again below, since the examiner's rejection is exactly the same now as when those arguments were originally written) were unpersuasive. It is not clear to Applicant what the issues are between the examiner's position and Applicant's position because the examiner has not responded to Applicant's position, and Applicant cannot feel that he has been given a "full and fair hearing" for claim 4. Applicant respectfully requests allowance of claim 4 or alternately a full and fair hearing for claim 4 that includes a response from the examiner regarding Applicant's arguments relating to claim 4.

The following arguments relating to claim 4 were originally presented in Applicant's response dated 7 September 2005 at pages 11-12 and are equally relevant at the present time, as described above:

Claims 2-4 and 6 depend from claim 1 and thus benefit from like arguments; reconsideration and withdrawal of the rejection of claims 2-4 and 6 under 35 U.S.C. 102(b) is likewise requested. However, certain of these claims have additional features that are not anticipated by Bjork. For example, claim 4 requires "the edge sections vary in flexibility." The Examiner states "Bjork teaches varying the thickness of the metal edges (14, 15) as well as varying the flexibility of the metal edges... See column 2, lines 43-48 and column 3, lines 31-61." Office Action, page 3. Applicant believes the first of these citations to refer to page 2, column 1, lines 43-48: "Great nicety in this arrangement is not required, since any irregularities will be so small as to be negligible. The strip metal used is only about .05 of an inch in thickness, and variation in the thickness of a few thousandths of an inch one way or another would not interfere in any way with the free action of the ski." Bjork, page 2, column 1, lines 43-49. But this passage does not teach edge sections that vary in flexibility; it teaches that small variation in flexibility are immaterial to the operation of Bjork's ski. This is reinforced by other passages from Bjork: "Such protecting runners must be made in short lengths and have a degree of resiliency equaling, if not greater than, the wood of the ski itself." Bjork, page 1, col. 1, lines 34-37. "The construction of the runner and the manner of applying it to the ski is such as to have no weakening effect upon the wood of the ski, but rather to provide a reinforcement along each edge thereof without sacrificing resiliency of the ski as a whole." Bjork, page 1, col. 2, lines 3-8. "The use of thin metal in the runner is essential because these runners must have as great or greater flexibility than the material

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of the ski itself, since such flexibility is necessary to the desired action of the ski.” Bjork, page 2, column 1, lines 50-54. The teaching of these passages is that the resiliency or flexibility of the “metal runners” is designed to be at least as great as that of wood of the ski itself; and that in such a context, variation in flexibility does not matter. Therefore Bjork does not teach varying flexibility of an edge. Reconsideration is requested.

Claim 7

As discussed at page 13 of Applicant’s response dated 7 September 2005, even if rails 7 and 8 of Hess (‘585) were considered grind plates (though they are not grind plates, as discussed below,) rails 7 and 8 are not disposed laterally with respect to edges 4 and 5. Instead, rails 7 and 8 are positioned underneath edges 4 and 5 and core 2. The examiner failed to address these arguments and explain why the edge sections should be considered laterally disposed, and as such, Applicant is again at a loss as to how his earlier arguments were unpersuasive.

According to paragraph 34 of Applicant’s amended specification submitted 7 September 2005, “[G]rind plates are designed to provide protection to a ski or snowboard edge during sliding or grinding.” “Grinding” and “sliding” involve doing tricks on or sliding on obstacles (e.g., metal rails, trees, benches). Applicant’s amended specification submitted 7 September 2005, paragraph 1. As such, anything that does not provide protection to a ski or snowboard edge during sliding or grinding on obstacles is not a “grind plate”.

There is absolutely no indication in Hess (‘585) that rails 7 and 8 are capable of supporting forces incurred while sliding or grinding on obstacles, or that rails 7 and 8 are capable of protecting edges 4 and 5 during sliding or grinding on obstacles. In fact, as previously noted, Hess (‘585) does not mention “grind plates” or anything to do with grinding skis on obstacles, and Hess (‘585) is structured to prevent or minimize tilting toward the external edge of the board, which is required in sliding or grinding on obstacles. Hess, col. 2, lines 35-37. Applicant respectfully contends that rails 7 and 8 are not grind plates, and the examiner has not set forth any reasoning as to why rails 7 and 8 should be considered grind plates.

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As each and every element of Applicant's claim 7 is not found, either expressly or inherently described, in Hess ('585), (i.e., "at least one grind plate" and the at least one grind plate being "disposed laterally with respect to the edges"), the current anticipation rejection of claim 7 cannot be supported under *Verdegaal*. Applicant respectfully requests allowance of claim 7 and claims 8-10, 13, and 14 that depend therefrom.

Claim 14

Applicant respectfully disagrees with the examiner's characterization of Figure 15 of Hess ('585). According to the examiner at page 4 of the 30 November 2005 Office Action, "Figure 15 [of Hess] clearly shows that the grind plates extend along a center region of the board body." It is extremely unclear to applicant from both Hess' specification and Figure 15 that Hess describes, either expressly or inherently, a grind plate extending along a center region of a board body. There is absolutely no indication as to where the section view of Figure 15 is taken. Applicant respectfully contends that Figure 15 could equally have been taken from a region other than a center region, and that Hess ('585) does not describe the limitations in claim 14 sufficiently to support an anticipation rejection under *Verdegaal*. Therefore, for these reasons as well as those given above in reference to claim 7, Applicant respectfully requests allowance of claim 14.

Claims 15-18

Claims 15-18 have been amended to change all limitations involving "edge sections" to "grind plates"

For the reasons discussed above in reference to claim 7, Hess ('585) does not describe, either expressly or inherently, a grind plate. In accordance with *Verdegaal*, therefore, Hess ('585) cannot anticipate amended claims 15-18 which include grind plates and various limitations relating to grind plates. Allowance of claims 15-18 is respectfully requested.

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Claim 19

Claim 19 has been rewritten in independent form. Hess ('585) does not describe, either expressly or inherently, providing a first set of edge sections that have different durability characteristics than a second set. These elements of claim 19 are not described where cited by the examiner (col. 2, lines 44-56) or anywhere else in Hess ('585). In accordance with *Verdegaal*, therefore, Hess ('585) cannot anticipate claim 19, and allowance of claim 19 is respectfully requested.

Claim 20

The examiner has cited col. 2, lines 44-56 of Hess ('585) as the basis for the current anticipation rejection. However, all of the limitations of claim 20 do not appear there. Nor are they described, either expressly or inherently, anywhere else in Hess ('585). Hess ('585) does describe, where the examiner cited, an ability to utilize a control device to change characteristics of a ski. This is clearly not the same as completely removing a grind plate for use of a gliding board on snow, as claimed by Applicant. This is a limitation that is absent from Hess ('585).

In addition, for the reasons discussed above in reference to claim 7, Hess ('585) does not describe, either expressly or inherently, a grinding plate.

Under *Verdegaal*, Hess ('585) cannot anticipate a method (i.e., claim 20) in which steps utilize elements that are absent from Hess ('585). For these reasons, Applicant respectfully requests allowance of claim 20.

35 U.S.C. § 103 Rejections

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bjork (U.S. 2,225,293) in view of Ford (U.S. 4,083,577). Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hess (U.S. 6,062,585) in view of Benner (U.S. 3,924,865). Claims 11 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bjork ('293).

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the

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claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Claim 5

Applicant respectfully contends that the examiner has improperly combined Ford ('577) with Bjork ('293), and that the combination of Ford ('577) and Bjork ('293) does not teach or suggest all the limitations present in claim 5.

Absent Applicant's disclosure, there would be no reason to combine Ford ('577) with Bjork ('293). It makes absolutely no sense to round the outer face of the Bjork ('293) edge sections 14, 15, as the Bjork edge sections 14, 15 are "only about .05 of an inch in thickness". Bjork, page 2, col. 1, lines 45-46. At any rate, such a small round would not provide a dull edge appropriate for sliding and grinding, as set forth in Applicant's claim 5, and the examiner's combination is based on impermissible hindsight since there is no motivation given in the references to combine Ford ('577) and Bjork ('293). Thus, the first and third criteria of *Vaeck* are not met by the current rejection.

Further, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). According to Bjork ('293), the purpose of the '293

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patent is to provide "a ski having metal edge runners which are so constructed as to...at all times ensur[e] sharp, substantially continuous, wear resisting bottom edges effective in assisting the skier when making sharp turns." Bjork, page 1, col. 1, lines 27-34, emphasis added. Insofar as rounding edge sections 14, 15 of Bjork would provide a dull edge for sliding and grinding, Bjork ('293) would be unsatisfactory for its stated intended purpose. This is clearly not allowed by *Gordon*.

For these reasons, in addition to depending from allowable claim 1 (as discussed above,) Applicant respectfully requests allowance of claim 5.

Claim 9

The examiner failed to address all of Applicant's earlier arguments regarding the patentability of claim 9, and as such, Applicant is once again at a loss as to how his earlier arguments were unpersuasive. More particularly, the examiner did not address Applicant's arguments that "neither Hess nor Benner discloses flexibility of the grind plates, and especially not that flexibility of the one or more grind plates accommodates intended use of the board." Instead, the examiner simply reprinted the earlier rejection verbatim. In addition, the examiner has never set forth where Benner teaches a grind plate that can vary in flexibility, and Applicant finds no such teaching or disclosure in Benner.

Because neither Hess ('585) nor Benner ('865), alone or in combination, discloses a flexibility of a grind plate that accommodates an intended use of a board, the current rejection fails the third criteria of *Vaeck*. In addition, claim 9 depends from patentable claim 7, as discussed above. For these reasons, applicant respectfully requests allowance of claim 9.

Claim 11

There is no teaching in the prior art to have a first edge section that comprises a first material and another edge section that comprises a second material. Nor is there any motivation in the prior art for such different edge sections. Also, from page 6 of the Current Office Action, it is clear that the examiner has failed to appreciate the limitations of claim 11. In lodging the current 35 U.S.C. § 103(a) rejection, the examiner wrote that

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"It would have been obvious...to use more than one material for a single edge section." Applicant offers no opinion on the truth of that statement, as it is not relevant to the limitations presented in claim 11. Claim 11 includes the limitations that "at least one of the edge sections comprises a first material and at least one other of the edge sections comprises a second material. Because the limitations of claim 11 are not found in or otherwise rendered obvious by the prior art references, either alone or in combination, because the examiner has failed to establish a *prima facie* case of obviousness against claim 11, and because claim 11 depends from patentable claim 1 as discussed above, Applicant respectfully requests allowance of claim 11.

Claim 12

There is no teaching in the prior art to have edge section that comprise composite materials, and because the composite materials are beneficial in sliding and grinding on obstacles (subjects that are absent in the prior art) instead of simply skiing or snowboarding in manners disclosed in the cited art, it would not have been obvious absent Applicant's disclosure to provide such edge sections. This is not simply a case of a worker selecting a known material for a prior use. Instead, it is an advancement brought about by Applicant's new edge sections designed for grinding and sliding on obstacles. Applicant respectfully requests reconsideration and allowance of claim 12.

Conclusion

In view of the above Amendments and Remarks, Applicant has addressed all issues raised in the Office Action dated 30 November 2005, and Applicant respectfully solicits a Notice of Allowance. Should any issues remain, the examiner is encouraged to telephone the undersigned attorney.

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The fee of \$100 for an additional independent claim in excess of three for a small entity is enclosed herewith. Applicant believes no other fees are currently due; however, if any fee is deemed necessary in connection with this Amendment and Response, please charge Deposit Account No. 12-0600.

Respectfully submitted,

LATHROP & GAGE L.C.

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